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Date: JUNE 27, 2006

To: EXAMINER DENNIS G. BONSHOCK
U.S. PATENT AND TRADEMARK OFFICE

Fax #: (571) 273-8300

From: FRANK C. NICHOLAS
Phone #: (847) 424.2521

Client/Matter No.: AUS920010923US1 (9000/81)

of Pages: 8

(including cover sheet)

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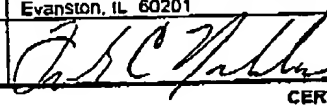
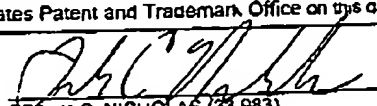
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| | | |
|---|----------------------|---------------------------|
| <h1>TRANSMITTAL FORM</h1> <p>(to be used for all correspondence after initial filing)</p> | Attorney Docket No. | AUS920010823US1 (8000/81) |
| | Application Number | 09/981,877 |
| | Filing Date | OCTOBER 18, 2001 |
| | First Named Inventor | ANTHONY E. MARTINEZ |
| | Group Art Unit | 2173 |
| | Examiner | BONSHOCK, DENNIS G |

| ENCLOSURES (check all that apply) | | |
|--|--|--|
| <input type="checkbox"/> Amendment <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Status Letter <input type="checkbox"/> Petition for Extension of Time Request (dup) <input type="checkbox"/> Express Abandonment Under 37 CFR 1.138 <input type="checkbox"/> Supplemental Information Disclosure Statement, PTO-1449, art <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application | <input type="checkbox"/> Assignment Papers <input type="checkbox"/> Drawings: <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> To Convert a Provisional Application <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request of Refund | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Reply Brief <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Post Card Receipt <input type="checkbox"/> Additional Enclosure(s) (please identify below) <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> |
| <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 09-0447 (IBM Corporation). A duplicate copy of this sheet is enclosed. | | |
| <input checked="" type="checkbox"/> I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 09-0447 (IBM Corporation). A duplicate copy of this sheet is enclosed. | | |

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| Total | | Minus | | 0 | x \$25= | 0 | x \$50= | |
| Indep. | | Minus | | 0 | x \$100= | 0 | x \$200= | |
| First Presentation of Multiple Dep. Claim | | | | | + \$180= | — | + \$380= | |
| | | | | | total add'l fee | \$ 0 | total add'l fee | \$ 0 |

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| Application Number | 09/981,877 |
| Filing Date | OCTOBER 18, 2001 |
| First Named Inventor | ANTHONY E. MARTINEZ |
| Group Art Unit | 2173 |
| Examiner | BONSHOCK, DENNIS G |

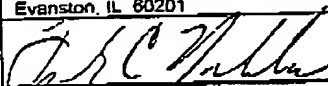
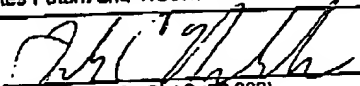
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| | | | | | Small Entity | | or | Large Entity | |
|---|------------------------|-------|---------------------------------|---------------|-----------------|-----------|----|-----------------|-----------|
| | Claims After Amendment | | Highest No. Previously Paid For | Present Extra | Rate | Add'l Fee | | Rate | Add'l Fee |
| Total | | Minus | | 0 | x \$25= | 0 | | x \$50= | |
| Incep. | | Minus | | 0 | x \$100= | 0 | | x \$200= | |
| First Presentation of Multiple Dep. Claim | | | | | + \$180= | — | | + \$360= | |
| | | | | | total add'l fee | \$ 0 | | total add'l fee | \$ 0 |

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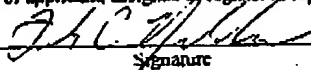
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FRANK C. NICHOLAS (33,983)

Name of applicant, assignee or registered representative



Signature

June 27, 2006

Date of Signature

PATENT
Case No. AUS920010923US1
(9000/81)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

ANTHONY E. MARTINEZ, ET AL.

Serial No.: 09/981,877

Filed: OCTOBER 18, 2001

Title: METHOD OF PREVIEWING A
GRAPHICAL IMAGE CORRESPONDING)
TO AN ICON IN A CLIPBOARD)

Examiner: BONSHOCK, DENNIS G.

Group Art Unit: 2173

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22202-1450

Dear Sir:

Appellants respectfully present their Reply Brief as follows:

June 27, 2006
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Serial No.: 09/981,877
Filed: October 18, 2001
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The Examiner fails to introduce any new support for his §102(a) rejection in his answer brief. Appellants maintain that the "MSWord" reference is not a §102(a) reference, and that "MSWord" does not disclose each element of the claims.

Claim 1 requires, *inter alia*, "displaying the graphical image associated with the icon in response to the icon preview instruction." Thus, a graphical image associated with the icon is displayed in response to an icon preview instruction. Three elements are present in this section of the claim: 1) an icon preview instruction, 2) an icon, and 3) a graphical image associated with the icon. In order to anticipate the claim, "MSWord" must disclose each element.

An "icon" is a picture on a screen that represents a specific file, directory, window, option, or program, according to an exemplary definition from *The American Heritage® Dictionary of the English Language, Fourth Edition*. In contrast, "text" is, according to the same source, "the original words of something written or printed, as opposed to a paraphrase, translation, revision, or condensation."

At most, the "reference" discloses that a *text* sample of the clipboard icon is disclosed upon a mouse action, and not the display of a *graphical* image associated with the icon. See, MS Figure 2. The Examiner's attempt to argue that text and graphics are identical is flawed.

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A box surrounding the graphical image of text is not associative of an icon, in contrast to the Examiner's arguments. See, p.6 of the Examiner's answer. A box is not associative of a "W."

Regardless of the merits of Appellants argument above, however, there can be no proper rejection of the claims based on "MSWord." While the Examiner correctly identifies the strictures of §102(a), the Examiner's statement that a copyright date "alone proves that the MSWord reference was known and used prior to the filing of the applicants claimed invention" illustrates a fundamental misconception of patent law.

The law is clear that a document only qualifies as a reference under 35 U.S.C. §102(a) "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that person interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." See MPEP 2128, *In re Wyer*, 655 F.2d 221 (CCPA 1981).

In contrast, 17 U.S.C. §102 states that "copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." Thus, the fact that a document claims copyright *does not mean* that the document has been disseminated or otherwise made available. Furthermore, that a document claims copyright to a date more than one year prior to the instant filing date does not mean that a particular portion of the document was included in the copyrighted work at the time that the copyright notice was

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affixed. For example, the Examiner indicates that the copyright notice claims copyright "1983-1999" but does not allege that the document was the same document during that time period, and does not allege that after 1999, the document ("MSWord") is the same document that was subject to a copyright claim in 1999.

The "MSWord" reference was generated by the Examiner more than 2.5 years after the instant filing, and this reference cannot support this rejection.

Allowance of claim 1, and all claims depending therefrom is requested.

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CONCLUSION

The Appellants respectfully submit that claims 1-16 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: June 27, 2006

Respectfully submitted,
ANTHONY E. MARTINEZ, *et al.*

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Frank C. Nicholas
Registration No. 33,983
Attorney for Appellants

Jennifer Cruz

From: Paul Hietko
Sent: Friday, June 23, 2006 12:04 PM
To: Jennifer Cruz
Cc: Debra Molinari
Subject: 9000/81

Please refile the Reply Brief previously filed.

Please file on or before July 6, 2006. File on my desk.

Paul M. Hietko
Patent Attorney
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